

Appl. No. 09/751,293

Amdt. Dated 06/21/2004

Reply to Office Action of March 19, 2004

REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed March 19, 2004.

In the Office Action, claims 6, 8, 17, 26, 35, 41, 49-50, and 56-57 were objected to and would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In response, Applicant has rewritten claims 6, 8, 17, 26, 49-50 and 56-57 to place these claims into independent form. These rewritten claims add no additional limitations and are consistent in same or even broader scope from their original dependent form. Claims 35 and 41 remain as dependent claims and in their objected state. These claims are allowable based on an allowability of their independent claims. Withdrawal of the objection is respectfully requested.

Moreover, claims 1-5, 7, 9-16, 18-25, 27-34, 36-40, 42-48 and 51-55 were rejected under 35 U.S.C. § 103(a). In particular, claims 1-5, 7, 9, 28-34, 36-40, 42-48 & 51-55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Engwer (USP 5,987,062) in view of IEEE Standard (ISO/IEC 8802-11, ANSI/IEEE Std 802.11, August 20, 1999 at pages 34-58 (hereinafter referred to as "IEEE 802.11 Standard") in further view of Menezes (USP 5,621,894). Claims 10-13, 16, 19-22 & 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Engwer in view of the IEEE 802.11 Standard and in further view of Menezes and Boldl (6,182,043). Claims 18 & 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Engwer in view of the IEEE 802.11 Standard in further view of Menezes and in further view of Boldl and Hwang (6,614,937). Claims 14-15 & 23-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Engwer in view of the IEEE 802.11 Standard and in further view of Menezes, Boldl and Kanljung (6,438,108). Applicant respectfully traverses these rejections in their entirety.

* Herein claims 1-5, 7, 9-16, 18-25, 27-34, 36-40, 42-48 and 51-55 are considered unpatentable over Engwer and secondary cited references. Applicants respectfully traverse the rejection because Engwer is not a valid prior art reference. The Office Action uses Engwer as a prior art reference under 35 USC § 103(a). However, 35 USC § 103(c) excludes references which

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may qualify as prior art under 35 USC § 102(e), (f), and (g) from being used as a prior art reference under 35 USC § 103(a). The text of 35 USC § 103(c) recites that

“[s]ubject matter developed by another person, which qualifies as prior art under one or more of subsections (e), (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” See 35 USC §103(c), MPEP 706.02(I)(1).

The subject matter of Engwer and the claimed present invention were, at the time the invention was made, owned by Nortel Networks Corporation or subject to an obligation of assignment to Nortel Networks Corporation. An assignment of the '062 patent to Nortel Networks Corporation was recorded at Reel No. 010871 and Frame No. 0324 in the U.S. Patent and Trademark Office as set forth in Exhibit 1. Furthermore, the subject application has an effective filing date of August 18, 2000, which is less than one year from the issue date of Engwer. Therefore, Engwer is not a valid prior art reference and does not obviate Applicants' claims 1-5, 7, 9-16, 18-25, 27-48 and 51-55 as pending.

Hence, withdrawal of the 35 USC §103(a) rejection is respectfully requested.

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Conclusion

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 06/21/2004

By


William W. Schaaf

Reg. No. 39,018

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Attachments

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Los Angeles, California 90025

CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8A)

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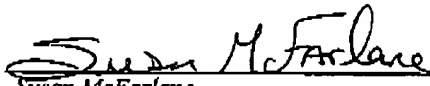
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Alexandria, VA 22313-1450.

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Trademark Office.

Date: 06/21/2004


Susan McFarlane

06/21/2004

Date

JUN. 21. 2004 2:18PM

BST- CM

NO. 2118 P. 23

EXHIBIT 1

Copy of Notice of Recordation of Assignment recorded at
Reel No. 010871 and Frame No. 0324



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ASSISTANT SECRETARY AND COMMISSIONER
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AUGUST 17, 2000

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7TH FLOOR
LOS ANGELES, CA 90025

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BLAKELY, SOKOLOFF ET AL
LOS ANGELES

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RECORDATION DATE: 06/23/2000

REEL/FRAME: 010871/0324

NUMBER OF PAGES: 8

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

NETWAVE TECHNOLOGIES LIMITED

DOC DATE: 12/29/1999

ASSIGNEE:

NORTEL NETWORKS CORPORATION
380 ST. ANTOINE STREET WEST
WORLD TRADE CENTER OF MONTREAL 8TH
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MONTREAL, QUEBEC, CANADA H2Y 3Y4

SERIAL NUMBER: 08439083

PATENT NUMBER: 5838730

FILING DATE: 05/11/1995

ISSUE DATE: 11/17/1998

SERIAL NUMBER: 08440436

PATENT NUMBER: 5717688

FILING DATE: 05/12/1995

ISSUE DATE: 02/10/1998

SERIAL NUMBER: 08439337

PATENT NUMBER: 5729680

FILING DATE: 05/11/1995

ISSUE DATE: 03/17/1998

ENTERED

SEP 08 2000

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JUN. 21. 2004 2:19PM

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NO. 2118 P. 25

010871/0324 PAGE 2

SERIAL NUMBER: 08787843
PATENT NUMBER: 5875186

FILING DATE: 01/23/1997
ISSUE DATE: 02/23/1999

SERIAL NUMBER: 08573272
PATENT NUMBER: 5987062

FILING DATE: 12/15/1995
ISSUE DATE: 11/16/1999

STEVEN POST, EXAMINER
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

06-29-2000



101392741

FORM PTO-1595

(Rev. 6-93)

OMD NO. 0651-0011 exp. 4/94

Recordation Form Cover Sheet PATENTS ONLY

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1. Name of conveying party(ies):

Netwave Technologies Limited

Additional name(s) of conveying party(ies) attached?

☒ No ☐ Yes

2. Name and address of receiving party(ies):

Nortel Networks Corporation

Internal Address: World Trade Center of Montreal8th FloorStreet Address: 380 St. Antoine Street WestCity: Montreal Province: Quebec Zip: H2Y 3Y4Country: CANADAAdditional name(s) & address(es) attached? ☒ No ☐ Yes

3. Nature of Conveyance

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4. Application Number(s) or patent number(s):

If this document is being filed together with a new application, the execution date of the application is:

A. Patent Application No.(s)

B. Patent No.(s)

Additional numbers attached? ☐ No ☒ Yes

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: Blackly, Sokoloff, Taylor & Zafman LLP

Internal Address:

Street Address: 12400 Wilshire Boulevard, 7th FloorCity: Los Angeles State: California Zip: 900256. Total number of applications and patents involved: 5

7. Total Fee (37 CFR 3.41).....\$200.00

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